



Copy #23

PATENT APPLICATION
Mo4861
HE-146

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION OF)
BERND WILLING) GROUP NO.: 3651
SERIAL NUMBER: 09/195,005) EXAMINER: J. VALENZA
FILED: NOVEMBER 18, 1998)
TITLE: DEVICE FOR INSERTING AND)
REMOVING WORK STATIONS)
CIRCULATING ON A CHAIN)

APPEAL BRIEF

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal mailed on May 20, 2003. The Notice of Appeal appeals the rejection of Claims 7-9 in the Final Office Action dated February 28, 2003.

The headings used hereinafter and the subject matter set forth under each heading are in accordance with 37 C.F.R. § 1.192(c).

RECEIVED
JUL 24 2003
GROUP 3600

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an enveloped addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 7/18/03

Date _____
Gary Matz, Reg. No. 45,504
Name of Appellant, Assignee or Registered Representative

Signature _____
July 18, 2003
Date _____

I. REAL PARTY IN INTEREST

The named inventor has assigned his interest in this application to Hennecke GmbH. Hennecke GmbH is therefore the real party in interest in this appeal.

II. RELATED APPEALS AND INTERFERENCES

The Appellant is unaware of other appeals or of any interference that would directly affect or be directly affected by, or have bearing on, the present appeal.

III. STATUS OF CLAIMS

Claims 7-9 are rejected under 35 U.S.C. § 112, first paragraph as being based on an inadequate disclosure because they contain elements deemed to be inadequately disclosed in the specification.

IV. STATUS OF AMENDMENTS

In Appellant's Amendment Under 37 CFR § 1.196(B)(1) dated November 13, 2002 in response to the new rejection to the claims made by the Board of Patent Appeals and Interferences in the Opinion mailed September 25, 2002, Appellant canceled Claims 1, 2, 3 and 6 and entered new Claims 7-9, which correspond to original Claims 1-3. In the Final Action dated February 28, 2004, the Examiner indicated that he was directed to enter the amendment.

V. SUMMARY OF THE INVENTION

The claims on appeal are directed toward a device for conveying work station wagons through a plurality of working steps. The device includes an oval track around which the work station wagons travel, an insertion guide track, and a removal guide track. The oval track includes a first guide strip forming a continuous first oval, a second guide strip spaced apart from the first guide strip and forming a second, larger oval, thereby forming a guide channel between the two guide strips, a drive chain travelling inside the guide channel, and the second guide strip having at least two gaps in its circumference. The insertion guide track is located outside the second guide strip, with a portion of the insertion guide track being parallel to a portion of the second guide strip. The removal guide track is located outside the

second guide strip, with a portion of the removal guide track being parallel to a portion of the second guide strip. Each of the work station wagons have at least one detachable connection element provided on one side detachably connecting the work station wagon to the drive chain and at least one connecting element provided on the side of the work station wagon opposite from the detachable connection element. The connecting element connects the work station wagon to the removal guide track.

The device operating by moving the work station wagons along the insertion guide track to a location where the detachable connection elements pass through one of the gaps and engage the drive chain. The work station wagons are conveyed around the oval track and once the work station wagons reach another one of the gaps, the detachable connection element is disengaged from the drive chain and the workstation wagons are connected via the connecting elements to the removal guide track.

VI. ISSUES PRESENTED

The following issue is presented in this Appeal:

- a) Whether Claims 7-9 are based on an inadequate disclosure.

VII. GROUPING OF CLAIMS

Claims 7-9 stand or fall together.

VIII. ARGUMENT

Each issue presented for review is addressed hereinafter under the appropriate heading:

Whether Claims 7-9 are based on an inadequate disclosure.

The Examiner has rejected Claims 7-9 under 35 U.S.C. § 112, first paragraph alleging that the terms "detachable connection element" and "connecting element", based on the September 25, 2002 decision of the Board of Patent Appeals and

Interferences, are not described in the specification adequately to describe the structure, operation, and manner of interaction with other elements of the claims.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

Manual of Patent Examining Procedure § 2163 (2003)

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA (1976)) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims"). The Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed. Wertheim, 541 F.2d at 262, 191 USPQ at 96. What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. MPEP § 2163 citing Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed Cir. 1986).

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. MPEP § 2163 citing In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an Appellant's disclosure a description of the invention defined by the claims. MPEP § 2163 citing Wertheim, 541 F.2d at 263, 191 USPQ at 97.

In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

MPEP § 2163

One claim limitation at issue is the "detachable connection element" shown in Figure 2, numbers 7 and 7', which engage the drive chain. In the embodiment described at page 3, lines 19 - 22, the "detachable connection element" consists of guide rollers mounted on vertically projecting mountings, with the guide rollers being removably connected to the drive chain (see page 5, lines 13 - 17). As described on page 6, lines 15-16, the connection can take the form of switchable electromagnets or rocker heels.

It appears that the board did not consider the entire specification when making this rejection. First, the specification describes the structure of the element, in one embodiment as guide rollers provided laterally on the work station wagon and removably fastened to carrier cages (page 5, lines 13-17) and in another embodiment as switchable electromagnets or rocker heels (page 6, lines 15-16). The specification describes the operation of the detachable connection element and its interaction with other claim elements in one embodiment as guide rollers that run in the channel.

Additionally, taking the plain meaning of the terms of the claim element into account demonstrates that the disclosure is adequate.

Detachable: to part; to separate or disunite; to disengage. Webster's New International Dictionary of the English Language, Neilson et al. Editors, Merriam Co., Springfield, MA (1955) p. 710.

Connection: state of being connected; junction; union. Webster's at 565.

Element: one of the constituent parts. Webster's at 829.

In other words, this claim element refers to a constituent part of the work station wagon, which provides joining or separating the work station wagon to/from

the drive chain. In addition to the above-mentioned methods provided in the specification, those skilled in the art would readily recognize how to provide for such joining and separating.

The other claim limitation at issue is the “connecting element,” which is clearly disclosed in one embodiment as guide rollers (see page 5, lines 19 - 20). These elements allow the work station wagons to move along the insertion guide track and along the removal guide track.

In other words, this claim element refers to a constituent part of the work station wagon, which provides joining the work station wagon to the removal guide track. In addition to the above-mentioned methods provided in the specification, those skilled in the art would readily recognize how to provide such joining.

The Examiner has not met his burden of establishing a *prima facie* case as to why the terms “detachable connection element” and “connecting element” are not adequately described in the specification. The Examiner has merely repeated, out of context, a statement in the decision by the Board in the previous appeal. “The purpose of the written description requirement of section 112, first paragraph is to state what is needed to fulfill the enablement criteria. ... The written description must communicate that which is needed to enable the skilled artisan to make and use the claimed invention.” Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

Appellants have met the standard of 35 U.S.C. § 112, first paragraph by first providing examples of “detachable connection element” and “connecting element” and providing sufficient description to enable a skilled artisan to avail himself to what is conventional or well known to one of ordinary skill in the art to reproduce the invention.

The Examiner has not presented any evidence, let alone a preponderance of evidence, demonstrating why a person skilled in the art would not recognize in

Appellant's disclosure a description of the invention defined by the claims, and in particular the terms "detachable connection element" and "connecting element".

Therefore, the rejection of Claims 7-9 under 35 U.S.C. § 112, first paragraph is improper and should be withdrawn.

IX. SUMMARY

In rejecting a claim, the Examiner must set forth express findings of fact regarding his analysis which support a lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. MPEP § 2163

The Examiner has not presented any evidence to support his *prima facie* case regarding the terms "detachable connection element" and "connecting element" and, therefore, has not met his burden of presenting, by a preponderance of evidence, why a person skilled in the art would not recognize what is meant by those terms. Appellants have presented sufficient factual evidence to show that a skilled artisan would be able to understand the claimed invention. Therefore, the holding that the written description requirement of 35 U.S.C. § 112, first paragraph has not been complied with is not correct because the subject terms are described in sufficient detail that one skilled in the art can reasonably understand the terms of the claim and conclude that the inventors had possession of the claimed invention at the time the application was filed.

X. CONCLUSION

The claims define a unique device for conveying work station wagons through a plurality of working steps. The Examiner has misinterpreted the specification and its relationship with the claims. In order to establish a *prima facie* case, the Examiner must show that the invention was not described in sufficient detail that one skilled in

the art could reasonably understand the terms of the claims and conclude that the inventors had possession of the claimed invention at the time the application was filed. The preponderance of evidence clearly establishes the allowability of Claims 7-9. Reversal of all of the Examiner's rejections and allowance of these claims are respectfully requested.

Respectfully submitted,

By 

Gary Matz
Agent for Appellants
Reg. No. 45,504

Bayer Polymers LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-3897
FACSIMILE PHONE NUMBER:
(412) 777-3902

/jme/GM/GM0025

APPENDIX - CLAIMS ON APPEAL

7. A device for conveying work station wagons through a plurality of working steps comprising:

- a) an oval track around which said work station wagons travel, said oval track comprising i) a first guide strip forming a continuous first oval, ii) a second guide strip spaced apart from said first guide strip and forming a second, larger oval, thereby forming a guide channel which is formed between said two guide strips, iii) a drive chain travelling inside said guide channel, and iv) said second guide strip having at least two gaps in its circumference,
- b) an insertion guide track located outside said second guide strip, with a portion of said insertion guide track being parallel to a portion of said second guide strip,
- c) a removal guide track located outside said second guide strip, with a portion of said removal guide track being parallel to a portion of said second guide strip,
- d) each of said work station wagons having i) at least one detachable connection element provided on one side of said work station wagon, said detachable connection element detachably connecting said work station wagon to said drive chain and ii) at least one connecting element provided on the side of said work station wagon opposite from said detachable connection element, said connecting element connecting said work station wagon to said removal guide track,

with said device operating as follows:

- 1) said work station wagons are moved along said insertion guide track to a location where said detachable connection elements pass through one of said gaps and engage said drive chain,
- 2) said work station wagons are conveyed around said oval track, and

3) once said work station wagons reach another one of said gaps, said detachable connection element is disengaged from said drive chain and said workstation wagons are connected via said connecting elements to said removal guide track.

8. The device of Claim 7, wherein each of said work station wagons is provided with a spacer that i) defines the minimum distance between said work station wagons when said work station wagons are engaged with said drive chain and ii) contacts the preceding work station wagon engaged with said drive chain.

9. The device of Claim 8, wherein each work station wagon is pushed along said insertion guide track and is pushed along said removal guide track by the following work station wagon.